

REMARKS

This response is submitted in response to the Final Office Action mailed March 12, 2004, to request reconsideration of the rejection of claims 27-30 and 32-35 as set forth therein. In the event the Examiner determines that the foregoing amendments do not place the case in condition for allowance, it is respectfully requested that the above amendments be entered to place the claims in better form for consideration on appeal.

Initially, the Applicant would like to thank the Examiner for the indication that claim 22 is allowed and claim 31 contains allowable subject matter.

With regard to claim 31, the same has been rewritten in independent form including all of the limitations of its base claim (27). Therefore, Applicants respectfully submit that claim 31 be allowed.

In the Official Action, the Examiner rejects claims 27-29, 32, 33, 34, and 35 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. 1989-172813 to Kenichiro et al., (hereinafter "Kenichiro"). Furthermore, the Examiner rejects claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Kenichiro in view of U.S. Patent No. 6,264,664 to Avellanet (hereinafter "Avellanet").

In response, independent claims 27, and 33-35 have been amended to clarify their distinguishing features.

The Examiner cites Kenichiro against the claims. Kenichiro is mentioned as prior art (1-172813) in the specification at paragraph [0008] as follows:

a medical retrieval instrument of the Japanese Utility Model Laid-Open Publication No. 1-172813 has a wire basket, one end of which is only held by a ring-like holding tube and fixed to a sheath.

As described in the specification, Kenichiro has a disadvantage as mentioned in the specification at paragraph [0008]:

Such a mounting configuration is unstable, since one end portion of the wire basket easily slips on the outer surface. Therefore, it takes more time to mount one end portion of the wire basket at a predetermined position and in a predetermined direction.

The present invention is directed to and overcomes such a disadvantage.

Specifically, the medical retrieval instrument of the present invention has an accommodation part (ex. a hole or groove) having a predetermined position and direction for accommodating and fixing one end of at least one filament so that this accommodation part regulates the one end of the at least one filament in the same predetermined position and direction.

Due to this distinctive feature, in an assembly process, one end portion of each filament is fixed at a predetermined position and in a predetermined direction determined by the accommodation part. This makes the assembly process easy [0058].

The groove 22 positions an end portion of each holding filament 7 and correctly regulates the direction in which the holding filament 7 extends out. In the assembly, if only one end portion of the holding filament 7 is engaged into the corresponding groove 22, positioning is finished. Since one end portion of each filament is fixed at a predetermined position and in a predetermined direction, assembly can be easily achieved.

On the other hand, Kenichiro only holds one end of each filament with a ring-like holding tube and doesn't disclose or suggest the features discussed above. Specifically, Kenichiro doesn't disclose the accommodating part (for example, a hole or groove) having a predetermined position and direction that regulates the direction filaments extend out in the

same predetermined direction. In other words, Kenichiro's ring does not have an ability to regulate the position and/or direction of the filament.

The independent claims have been amended to clarify the distinguishing features discussed above. As evidenced above, such a feature is fully supported in the original disclosure. Therefore, no new matter has been entered into the disclosure by way of the present amendment.

With regard to the rejection of claims 27-29, 32, 33, 34, and 35 under 35 U.S.C. § 102(b), a medical retrieval instrument having the features described above and as recited in independent claims 27 and 33-35 are nowhere disclosed in Kenichiro. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 27 and 33-35 are not anticipated by Kenichiro. Accordingly, independent claims 27 and 33-35 patentably distinguish over Kenichiro and are allowable. Claims 28, 29, and 32 being dependent upon claim 27, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 27-29, 32, 33, 34, and 35 under 35 U.S.C. § 102(b).

With regard to claim 30, since independent claim 27 patentably distinguishes over the prior art and is allowable, claim 30 is at least allowable therewith because it depends from an allowable base claim.

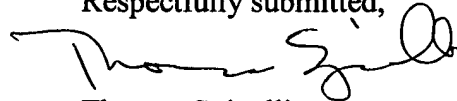
In other words, Independent claim 27 is not rendered obvious by the cited references because neither the Kenichiro patent nor the Avellanet patent, whether taken alone or in combination, teach or suggest a medical retrieval instrument having the features

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

discussed above. Accordingly, claim 27 patentably distinguishes over the prior art and is allowable. Claim 30 being dependent upon claim 27 is thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 30 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli", with a stylized flourish at the end.

Thomas Spinelli

Registration No.: 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

TS:cm